

In the Office Action, the Examiner asserted that column 6, lines 15-22 and 46-50 of the Nunes patent discloses both the acrylic backboard and elastomeric adhesive elements of the instant invention. In studying the Nunes patent, the applicant found only teachings of a novelty desk lamp and clock in the form of a "simulated" or "miniature basketball backboard."

Applicant could not find a disclosure or teaching in Nunes of a backboard frame structure having a bonding surface, an acrylic backboard having a bonding surface, and an elastomeric adhesive sandwiched between the frame and the backboard. Therefore, applicant submits that claim 1 is not properly anticipated by Nunes.

The acrylic backboard element is an element which appeals to consumers due to its durability, appearance, ability to be molded and printed on, and its resemblance to professional basketball backboards. Nunes does not disclose or suggest acrylic backboards. The word "acrylic" is not even found in Nunes. Instead, Nunes teaches miniature ornamental backboards for use in desk lamps and clocks. A separate backboard frame structure is not disclosed by Nunes. Nunes discloses a simulated foam strip (70) affixed to the backboard face, but the foam strip (70) is not a backboard frame structure. Nunes also discloses a magnet (69) affixed to the backboard, but again, the magnet (69) is not a backboard frame structure.

The elastomeric adhesive of the applicant's invention is similarly not taught by Nunes. This element is important to the applicant's invention since the bond between the backboard and the frame should be both flexible and durable. (Specification, page 1, beginning at line 21.) Nunes teaches away from the use of elastomeric adhesives, listing first a magnet as the "mounting means," then listing a "permanent adhesive" only as part of a list of such means including suction cups, repositional adhesive, hooks, or hook receiving holes, none of which can be considered an "elastomeric" adhesive. These listed mounting means do not have the durable and flexible characteristics of the elastomeric adhesives taught in the instant application. Finally,

I. **35 U.S.C. § 102(b) Rejection**

In the Office Action dated August 16, 2000, the Examiner rejected claim 1 as being anticipated by U.S. Patent No. 5,677,896, to Nunes. Specifically, the Examiner asserted that Nunes discloses “a frame (69), an acrylic backboard (6:15–22) and an elastomeric adhesive (6:46–50).” *Office Action*, p. 2. The applicant asserts that Nunes does not disclose these elements sufficiently to anticipate the instant invention.

The standard for anticipation is set in 35 U.S.C. § 102(b), as quoted by the examiner, states that “[a] person shall be entitled to a patent unless . . . (b) the invention was patented or . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of application for patent in the United States.” The Examiner rejected claim 1, asserting that Nunes anticipates the applicant’s invention. The applicant believes that the instant invention was not “patented or described” by Nunes, and thus that its claims are patentably distinct from the teachings of Nunes.

First, the applicant’s invention differs in structure from that taught in the Nunes patent, and is thus not anticipated by it. In distinguishing a section 102 rejection from a section 103 rejection, the MPEP notes that “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” According to claim 1 of the instant application, the applicant’s invention is comprised of at least the following elements: “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and an elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface.” The Nunes patent does not teach an acrylic backboard, a backboard frame structure, a bonding surface on the frame, a bonding surface on the backboard, or the use of an elastomeric adhesive between the frame and the acrylic backboard, and thus Nunes does not anticipate the applicant’s invention.

Nunes fails to teach the use of the bonding surfaces found both on a surface of the backboard and the frame of the instant invention. These elements are important to successful use of the disclosed elastomeric adhesives because bonding surface preparation affects adhesion. Since each of the above elements of the instant invention are not taught by Nunes, it cannot function as an anticipating reference. Withdrawal of the rejection of claim 1 is requested.

## II. 35 U.S.C. § 103(a) Rejections

The Examiner next rejected claims 2–18 under 35 U.S.C. § 103(a) as being unpatentable over Nunes as applied to claim 1, and in view of Hying, et al. The provisions of 35 U.S.C. 103 prevent the patenting of inventions when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” A prima facie showing of obviousness is successfully made when an Examiner establishes that:

1. There is a suggestion either in the references cited themselves or in the art to combine the references and their teachings.
2. There is a reasonable chance of succeeding in combining the teachings.
3. The prior art references teach all of the claim limitations.

Since these showings have not been made, withdrawal of the rejection is respectfully requested.

In the instant case, the Examiner argues that Nunes discloses all of the elements of claim 1, Hying discloses a metal backboard frame, and that the combination of these elements from their disparate technologies “would have been obvious to one of ordinary skill in the art . . . in order to provide a more rigid and durable device to extend the useful life of the apparatus.”

*Office Action*, p. 2, no. 3. The Examiner gave no patentable weight to the claim limitations of claims 2-10 and 12-18 relating to the type of adhesive used, the amount and method of

application of the adhesive, the painted metal frame, the printed matter on the backboard, or the type or structure of bond gap spacers used with the adhesive.

First, the Examiner argues that the combination of Nunes and Hying constitutes the invention of the instant application. Applicant submits that there is no suggestion or motivation in the Nunes or Hying patents to combine the technologies used in a novelty “desk top lamp and clock” and a “steel framed basketball backboard with plastic retainer and method of making same.” Additionally, neither of these patents teaches that such a combination would enjoy any probability of success. Given that Nunes fails to disclose or suggest the features of claim 1, as discussed above, applicant submits that the combination of Nunes and Hying fails to render claims 2-18 obvious. Withdrawal of the rejection is respectfully requested.

Moreover, applicant asserts that the type of adhesive, the method of its application, and the bond spacers used, further distinguish the claimed invention from the prior art. First, as noted on page 1 of the specification, success in using acrylic backboards is dependent on (1) adequate bonding with (2) sufficient flexibility to “dissipate . . . impact energy from the backboard to the frame.” In the prior art, these requirements have been met by using a two-sided tape with a foam center in mounting acrylic backboards, despite the labor-intensive nature of the assembly process involved. The conventional use of two-sided tape is even disclosed by Hying et al., column 2, lines 15-16; Fig. 2.

The applicant has invented a novel basketball backboard assembly using a method of construction using elastomeric adhesives to bond acrylic backboards to frames which solves the problems found in the prior art. In this method, the type of adhesive used (*i.e.*, elastomeric adhesive) is important because it dictates the characteristics of the bond formed between the acrylic backboard and the frame. The method of application is important since, as noted on p. 3 of the specification, the ability to apply adhesive using “commercially available robotic

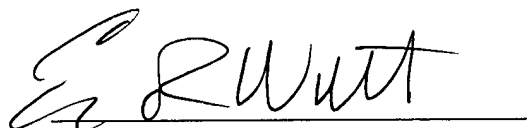
equipment” “improv[es] the efficiency and cost of the basketball backboard assembly process.”

Finally, the type and structure of the bond spacers used is important, since, as noted on p. 3 of the specification, the bond gap influences both adhesion and flexibility, and since the bond gap may be controlled through the use of “a plurality of bond gap spacers within the adhesive bond.”

Additionally, the use of printing on the bonding surface of the acrylic backboard serves to prepare the bonding surface for the application of adhesive without a separate step, as disclosed in the specification, pages 7–8. Although the use of painted metal is not “critical” to the invention, the Examiner is reminded that Section 103(a) of the Patent Act does not require dependent claims to be drawn to “critical” features. Therefore, “relevance” and “criticality” of claim features are not valid issues in rejecting claims under Section 103(a).

In view of the foregoing, the Applicant respectfully submits that claims 1–18 are in condition for immediate allowance. In the event that there remains any impediment to prompt allowance of the claims that could be clarified by a telephonic interview, the Examiner is invited to initiate the same with the undersigned attorney for the Applicant.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'E. R. Witt', is written over a horizontal line.

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